

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Harry Michael Schell
Serial No.: 10/627,110
Filed: July 25, 2003
For: METHODS AND COMPUTER PROGRAM PRODUCTS THAT
CONDITIONALLY ROUTE PRINT FILES

Confirmation No.: 3761
Group Art Unit: 2176
Examiner: Laurie Anne Ries

January 10, 2008

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §41.41

Sir:

Appellant's Reply Brief is filed in response to the Examiner's Answer mailed November 14, 2007. This Reply Brief highlights how the Examiner's Answer continues to fail to establish a *prima facie* case of obviousness in rejecting the pending claims.

For at least the reasons explained in Appellant's Brief on Appeal and the present Reply Brief, Appellant requests reversal of the claim rejections and passing of the application to issue.

Appellant notes that the Examiner's remarks in Section 9 "Grounds of Rejection" of the Examiner's Answer are word-for-word identical to that provided in the Final Office Action as bases to reject the pending claims. Accordingly, Appellant will only address any new bases provided by the Examiner in Section 10 "Response to Argument" of the Examiner's Answer.

1. Independent Claims 6 and 16 are patentable over Tanaka

The Examiner's remarks on page 11 of the Examiner's Answer appear to make an error in interpreting how "print file" is defined *by the claims*, and make a clear error in understanding Tanaka's description of the "settings file" which the Examiner's Answer erroneously contends is printed.

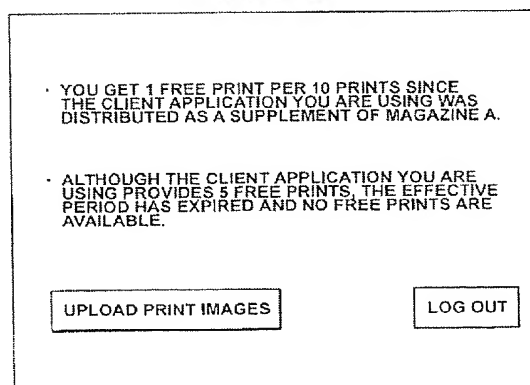
Regarding the definition of "print file" in Claims 6 and Claim 16. Claim 6 recites, *inter alia*, "evaluating content of at least one *print file* based on a routing policy, *wherein the print file is configured by an application for printing on a printer device.*"

Accordingly, Claim 6 expressly recites that the print file is configured by an application for printing on a printer device. The Examiner Answer on page 11 states, without further explanation, that "the Appellant has applied a narrow definition of 'print file' that is not supported by Applicant's Specification." However, Appellant notes that Claim 6 clearly defines a "print file" as being "configured by an application for printing on a printer device", which is supported throughout the present application specification (e.g., at pages 5 and 6).

In an attempt to read Tanaka's "settings file" on the print file of Claim 6, the Examiner has cited Tanaka's description at paragraph 0045, which is repeated below (emphasis added) along with FIG. 6 referenced therein:

[0045] FIG. 6 is the Web page displayed on the personal computer 10 by the service provision unit 130 . As has been described above, the content of the setting file A of the client application comprises "magazine A" as the distribution route information, "privilege service 1" as the name of the privilege service, and "Jan. 1 to 10, 2002" as the effective period of the privilege service. Therefore, the service provision unit 130 searches the distribution route database 115 , and selects two of the distribution route services "1 free print per 10 prints" and "displaying a banner advertisement of the magazine A". Since the name of the privilege service included in the setting file A is "privilege service 1", the service provision unit 130 searches the privilege service database 120 to select the privilege service 1, "5 free prints". However, the service provision unit 130 confirms the information on the effective period "Jan. 1 to 10, 2002" attached to the setting file A, and recognizes that the effective period for the user of the client application has expired. Therefore, the service provision unit 130 displays on the personal computer 10 the content of the services and a "Upload Print Images" button for uploading the image data to be printed, as shown by the page in FIG. 6 .

FIG.6



Appellant submits that Tanaka's paragraph 0045 in no way supports the Examiner's contention that Tanaka's "settings file" is configured to be printed. Indeed, in sharp contrast thereto, Tanaka's paragraph 0045 confirms that "the content of the setting file" is analyzed to identify from what magazine a client obtained the setting file (e.g., "magazine A" or "magazine B"), the type of service available to the client (e.g., number of free print outs available), and an expiration date for the service. More particularly, Tanaka displays the Web page of FIG. 6 when the setting file indicates that it was CD supplement was distributed in "magazine A" (See also Tanaka, Para. 0039), that the client is awarded "5 free prints" before expiration of the effective period of the offer, and is awarded "1 free print per 10 prints" after "the effective period has expired." The client can make use of the print service to print a photo(s) on the client's computer by selecting the "Upload Print Images" that Tanaka displays on the Web page of FIG. 6 to "upload// image data to be printed." (Tanaka, Para. 0045)

Consequently, although the settings file contains information that is used by Tanaka's system to determine whether printing will be allowed and, if so, how many prints, the settings file is in no way configured to be printed by a printer device. Indeed, the client must click on the displayed "upload print images" button and separately supply image files that the client wants to upload to Tanaka's system for printing by a printer device. Accordingly, the uploaded image file is a print file because it is configured by the personal computer (10) for printing (step S75 of FIG. 5) by the print server (100), while *the setting file is not a print file because it is not configured to be printed and, indeed, it is not printed (step S75 of FIG. 5).* Appellant incorporates by reference the explanation on pages 7-8 of Appellant's Amended Brief on Appeal of September 18, 2007, which sets forth further evidence from Tanaka that proves that the settings file is in no way configured to be printed by a printer device.

Appellant therefore submits that Tanaka does not describe or suggest the first paragraph of Claim 6, below:

evaluating content of at least one *print file* based on a routing policy,
wherein the print file is configured by an application for printing on a printer device .

Moreover, Tanaka does not describe or suggest the second paragraph of Claim 6:

selectively routing the print file based on the evaluated content of the at least one print file *to a non-printer device instead of to a printer device in response to the evaluated content of the print file.*

The Examiner's Answer on page 12 clearly misinterprets Tanaka by reading Tanaka's paragraphs 0045-0046 on the "selectively routing" recitations of the second paragraph of Claim 6. Tanaka's paragraph 0045 has been repeated above, and it's paragraph 0046 is repeated below:

[0046] FIG. 7 is a Web page displayed by the service provision unit 130 after the user of the personal computer 10 clicks the "Upload Print Images" button in the page shown in FIG. 6 for uploading the image data.
(Tanaka paragraph 0046, emphasis added).

Appellant submits that nowhere in paragraphs 0045-0046, nor elsewhere, does Tanaka describe or suggest *that the image file is selectively routed to a non-printer device instead of being printed by the print server (100) in response to evaluation of the content of the image file based on a routing policy.* Instead, Tanaka teaches that if no print services are to be awarded to a user, then the "Upload Print Images" button would not be selectable by a user to "upload image data to be printed." Tanaka does not describe or suggest that after a user has uploaded image data, that its system then decides whether or not to print the image data and, much less, does not describe or suggest that the uploaded image data is selectively routed to a non-printer device instead of to a printer device in response to the evaluated content of the uploaded image data.

For at least these reasons, Appellant submits that Claim 6 is patentable over Tanaka, because Tanaka does not describe or suggest evaluating content of at least one print file, which is configured for printing by a print device, based on a routing policy. Moreover, Tanaka does not describe or suggest selectively routing the print file, based on the evaluated content of the print file, to a non-printer device instead of to a printer device. Accordingly, a *prima facie* case of obviousness over Tanaka has not been made, and the rejection of Claim 6 under 35 USC §103(a) should be reversed.

Independent Claim 16 is a computer program product claim that includes recitations that correspond to Claim 6 and, consequently, is submitted to be patentable over Tanaka for at least the reasons explained for Claim 6.

2. Independent Claim 21 is Patentable Over Berard in view of Tanaka and Madison

Claim 21 recites (emphasis added):

21. A method of routing print files in a computer system, the method comprising:
- searching content of a print file to identify one or more keywords that are defined by a routing policy, wherein the print file is configured by an application for printing on a printer device; and
 - selectively renaming the print file based on identifying the one or more keywords in the print file instead of routing the print file to a printing device.

Accordingly, Claim 21 recites that the print file is configured by an application for printing on a printing device, and that the *print file is selectively renamed based on identifying one or more keywords contained in the print file that are defined by a routing policy, instead of routing the print file to a printing device.*

The Examiner's Answer provides the following reasoning for rejecting Claim 21:

Tanaka teaches a print file as discussed above in relation to Claim 6 and 16. Tanaka further teaches searching the contents of the print file to identify keywords defining a routing policy, such as the distribution route information, name, and privilege service.

However, as explained above, Tanaka analyzes the contents of a magazine supplied setting file (which is not printed), not the contents of a separate user supplied image file that is to be printed. Moreover, nowhere does Tanaka describe or suggest that a print file is selectively renamed based on identifying one or more keywords contained in the print file that are defined by routing policy, instead of routing the print file to a printing device.

Furthermore, the Examiner's Answer does not rebut the Examiner's earlier admission and Appellant's argument that Berard and Madison also fail to disclose these recitations of Claim 21 missing from Tanaka.

In particular, the Final Office Action on page 9 concedes that "Berard does not disclose expressly searching the content of the file to identify one or more keywords that are defined by a routing policy or selectively renaming the file based on the identified keywords."

The Final Office Action contended on page 8 that "Madison discloses renaming a file based upon the data within the file, such as XML data indicating a successful or unsuccessful file upload, and a routing policy, such as the value of the XML data updated according to the result of the upload attempt." Appellant acknowledges that Madison discloses that a file is selectively renamed based on whether it was successfully uploaded. However, nowhere does Madison appear to disclose that a file is selectively renamed in response to what that file contains, or, much less, that a print file is selectively renamed in response to identifying within the print file one or more keywords that are defined by a routing policy.

Accordingly, in view of the Examiner's Answer, a *prima facie* case of obviousness over Berard in view of Tanaka and Madison still has not been made, and the rejection of Claim 21 under 35 USC §103(a) should be reversed.

3. Dependent Claims 5 and 15 are Independently Patentable Over Tanaka in view of Madison

The Examiner's Answer has provided no new bases, and instead maintains the rejections on the previous stated bases. Accordingly, Appellant's earlier remarks in Appellant's Amended Appeal Brief are incorporated by reference.

4. Dependent Claims 7 and 17 are Independently Patentable Over Tanaka

Dependent Claims 7 and 17 recite that the print file is selectively posted on a Web page, instead of being routed to a printer device for printing, based on evaluation of the print file and a routing policy.

As explained above, Tanaka describes that the image files uploaded to the print server (100) are printed (step S75 in FIG. 5). The Examiner's Answer refers to paragraphs 0042 and 0045 of Tanaka which do not describe or suggest that a print file is

selective posted on a Web page. Tanaka instead posts content of the "setting file" on a WEB page (S60, FIG. 5) so as to query a client to provide an image file for uploading and to inform the client as to how many prints are allowed. (See Tanaka, FIG. 7). Tanaka does not describe or suggest that the print file itself can be selectively posted on a WEB page or, much less, that an uploaded image file is selectively posted on a Web page instead of being routed to a printer device. Indeed, Tanaka teaches that two distinct and separate types of files are needed for operation, a setting file that is distributed with magazines and defines what printing services may be used by a particular user, and a separate image file that is uploaded by the user.

Neither the cited paragraph of Tanaka nor elsewhere does Tanaka describe or suggest that a print file is selectively posted on a WEB page instead of being sent to a printer device for printing in response to evaluation of the contents of the print file and a routing policy. Accordingly, in view of the Examiner's Answer, a *prima facie* case of obviousness over Tanaka has still not been made, and the rejection of Claims 7 and 17 under 35 USC §103(a) should be reversed.

5. Dependent Claims 9 and 19 are Independently Patentable Over Tanaka in view of Berard

The Examiner's Answer has provided no new bases, and instead maintains the rejections on the previous stated bases. Accordingly, Appellant's earlier remarks in Appellant's Amended Appeal Brief are incorporated by reference.

VII. Conclusion

In light of the above discussion, Appellant submits that the pending claims are directed to patentable subject matter and, therefore, requests reversal of the rejections of the claims and passing of the application to issue.

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It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 50-0220.

Respectfully submitted,

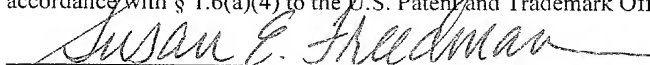


David K. Purks
Registration No. 40,133
Attorney for Appellant

Customer Number 39072
Myers Bigel Sibley & Sajovec, P.A.
P.O. Box 37428
Raleigh, NC 27627
919-854-1400
919-854-1401 (Fax)

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Susan E. Freedman

Date of Signature: January 10, 2008